

## **REMARKS**

Applicants respectfully request reconsideration of the present Application. Claims 1, 6, 13, 16, 18-24, and 30 have been amended herein. Care has been exercised to introduce no new matter. Claims 1-24 and 30-31 are pending and are in condition for allowance.

### **Rejections based on 35 U.S.C. § 112**

#### **Indefiniteness**

Claims 19-23 were rejected under 35 U.S.C. §112, second paragraph, as ostensibly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 23 claimed the animated icon, with no antecedent basis, and claim 19 recited computer-readable storage media, while dependent claims 20-23 recited computer readable storage medium. Claims 16 and 22 were rejected for recitation of the limitation “its.” Applicants respectfully traverse and request withdrawal of said rejection for the following reasons.

Claim 23 has been amended to depend from claim 20 rather than claim 19; therefore, proper antecedent basis is now established. Claims 20-23 have been amended to recite computer readable storage media; therefore, claims 20-23 are now consistent with independent claim 19. Claims 16 and 22 have been amended to replace “its” with “the animated icon’s”, thereby providing further clarification of the claimed subject matter.

### **Rejections based on 35 U.S.C. § 102**

#### **A) Applicable Authority**

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdeggal Brothers v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.

1987). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). *See also*, MPEP §2131.

B) Anticipation Rejection Based on Microsoft XP screen caps, XP.pdf operating system (hereinafter “XP”).

Claims 1-2 and 12 were rejected under 35 U.S.C. §102(b) as being anticipated by XP. Applicants respectfully traverse and request withdrawal of said rejection for the following reasons.

Independent claim 1 has been amended to require, in part,

“a first area containing a compact listing of menu items, the first area further comprising: an operating system section consisting of commonly accessed operating system specific items and a single menu item expanding access to all other operating system specific items; and an application program section consisting of commonly accessed application program specific items and a single menu item expanding access to all other application program specific items, wherein the operating system section is grouped completely separately from the application program section.”

Said amendment is supported by Applicants’ specification at para. 48-49 and Figs. 6a and 6b. Even though XP discloses a menu item to expand all application program specific items, XP does not describe a similar menu item to expand all other operating system specific items, in addition to the commonly accessed operating system specific items. XP also does not describe a completely separated application program section from an operating system section. In addition, claim 1 requires an operating system section consisting of ... as well as an application program section consisting of ... Therefore, the two sections do not contain any menu items outside of that being claimed. Amended independent claim 1 is now allowable over

the prior art of record. Similarly, dependent claims 2 and 12 are also allowable over the prior art of record, at least for the reasons discussed above with regard to amended independent claim 1.

### **Rejections based on 35 U.S.C. § 103**

#### **A) Applicable Authority**

Title 35 U.S.C. § 103(a) declares, a patent shall not issue when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” The Supreme Court in *Graham v. John Deere* counseled that an obviousness determination is made by identifying: the scope and content of the prior art; the level of ordinary skill in the prior art; the differences between the claimed invention and prior art references; and secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1 (1966). To support a finding of obviousness, the initial burden is on the Office to apply the framework outlined in *Graham* and to provide some reason, or suggestions or motivations found either in the prior art references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the prior art reference or to combine prior art reference teachings to produce the claimed invention. See *Application of Bergel*, 292 F.2d 955, 956-957 (CCPA 1961). Recently, the Supreme Court elaborated, at pages 13-14 of the *KSR* opinion, it will be necessary for [the Office] to look at interrelated teachings of multiple [prior art references]; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by [one of] ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the [patent application]. *KSR v. Teleflex*, No. 04-1350, 550 U.S. 398 (2007).

B) Obviousness Rejection Based on Microsoft XP screen caps, XP.pdf operating system (hereinafter “XP”) and M. Yamaguichi, YZ.pdf (hereinafter “YZ”).

Claims 3-8 and 10-11 were rejected under 35 U.S.C. §103(a) as being unpatentable over XP in view of YZ. Applicants respectfully traverse and request withdrawal of said rejection for the following reasons.

Claims 3-8 and 10-11 depend from independent claim 1. As discussed above, independent claim 1 has been amended, and is now allowable over the prior art of XP. YZ is directed to miscellaneous information for an icon management software program, and does not compensate for the deficiencies of XP. In addition, dependent claim 11 is allowable on its own merits. The Office alleged that YZ describes claim 11, in that YZ discloses, the icon rocks up and down to confirm a user selection (see Office Action p. 7). However, acknowledging a user selection does not describe the claim 11 feature of indicating an action that will occur if an icon is selected. Therefore, dependent claims 3-8 and 10-11 are also now allowable over the prior art of record.

C) Obviousness Rejection Based on Microsoft XP screen caps, XP.pdf operating system (hereinafter “XP”), M. Yamaguichi, YZ.pdf (hereinafter “YZ”), and U.S. Patent No. 5,452,414 (hereinafter “Rosendahl”).

Claim 9 was rejected under 35 U.S.C. §103(a) as being unpatentable over XP, YZ and Rosendahl. Applicants respectfully traverse and request withdrawal of said rejection for the following reasons.

Claim 9 depends from independent claim 1. As discussed above, independent claim 1 has been amended, and is now allowable over the prior art of XP. YZ is directed to miscellaneous information for an icon management software program and does not compensate

for the deficiencies of XP. Rosendahl is directed to a three-dimensional icon (see Rosendahl Abstract) and does not compensate for the deficiencies of XP or YZ. Therefore, dependent claim 9 is also now allowable over the prior art of record.

D) Obviousness Rejection Based on Microsoft XP screen caps, XP.pdf operating system (hereinafter “XP”) and Gardner et al U.S. Patent No. 7,003,734 (hereinafter “Gardner”),

Claims 13 and 19 were rejected under 35 U.S.C. §103(a) as being unpatentable over XP in view of Gardner. Applicants respectfully traverse and request withdrawal of said rejection for the following reasons.

Independent claim 13 has been amended to require, in part, “receiving a first user input that causes a pointer to be located over a menu item of an operating system section, the operating system section consisting of commonly accessed operating system specific items and a single menu item expanding access to all other operating system specific items.” Independent claim 13 also requires, in part, “receiving a second user input that causes a pointer to be located over a menu item of an application program section, the application program section consisting of commonly accessed application program specific items and a single menu item expanding access to all other application program specific items.” Even though XP discloses a menu item to expand all application program specific items, XP does not describe a similar menu item to expand all other operating system specific items, in addition to the commonly accessed operating system specific items. XP also does not describe a completely separated application program section from an operating system section. In addition, claim 13 requires an operating system section consisting of ... as well as an application program section consisting of ... Therefore, the two sections do not contain any menu items outside of that being claimed. Gardner is directed to

creating and displaying pop-up images (see Gardner Abstract), and does not compensate for the deficiencies of XP. Therefore, amended independent claim 13 is now allowable over the prior art of record.

Independent claim 19 has been amended to require, in part,

“an operating system section consisting of commonly accessed operating system specific items and a single menu item expanding access to all other operating system specific items; and an application program section consisting of commonly accessed application program specific items and a single menu item expanding access to all other application program specific items, wherein the operating system section is grouped completely separately from the application program section.”

Even though XP discloses a menu item to expand all application program specific items, XP does not describe a similar menu item to expand all other operating system specific items, in addition to the commonly accessed operating system specific items. XP also does not describe a completely separated application program section from an operating system section. In addition, claim 19 requires an operating system section consisting of ... as well as an application program section consisting of ... Therefore, the two sections do not contain any menu items outside of that being claimed. Gardner is directed to creating and displaying pop-up images (see Gardner Abstract), and does not compensate for the deficiencies of XP. Therefore, amended independent claim 19 is now allowable over the prior art of record.

E) Obviousness Rejection Based on Microsoft XP screen caps, XP.pdf operating system (hereinafter “XP”), Gardner et al U.S. Patent No. 7,003,734 (hereinafter “Gardner”), and M. Yamaguichi, YZ.pdf (hereinafter “YZ”).

Claims 14-18 and 20-24 were rejected under 35 U.S.C. §103(a) as being unpatentable over XP, Gardner and in view of YZ. Applicants respectfully traverse and request withdrawal of said rejection for the following reasons.

Claims 14-18 depend from amended independent claim 13. As discussed above, amended independent claim 13 is now allowable over the prior art of XP and Gardner. YZ is directed to miscellaneous information for an icon management software program and does not compensate for the deficiencies of XP or Gardner. Therefore, dependent claims 14-18 are also allowable over the prior art of record, at least for the reasons discussed above with regard to amended independent claim 13. Claims 20-24 depend from amended independent claim 19. As discussed above, amended independent claim 19 is now allowable over the prior art of XP and Gardner. YZ is directed to miscellaneous information for an icon management software program and does not compensate for the deficiencies of XP or Gardner. Therefore, dependent claims 20-24 are also allowable over the prior art of record, at least for the reasons discussed above with regard to amended independent claim 19.

F) Obviousness Rejection Based on Microsoft XP screen caps, XP.pdf operating system (hereinafter “XP”), Gardner et al U.S. Patent No. 7,003,734 (hereinafter “Gardner”), M. Yamaguichi, YZ.pdf (hereinafter “YZ”), and Viellescaze et al. U.S. Publ. No. 2004/0179043 (hereinafter “Viellescaze”).

Claim 17 was rejected under 35 U.S.C. §103(a) as being unpatentable over XP, Gardner, YZ, and in view of Viellescaze. Applicants respectfully traverse and request withdrawal of said rejection for the following reasons.

Claim 17 depends from amended independent claim 13. As discussed above, amended independent claim 13 is now allowable over the prior art of XP and Gardner. YZ is

directed to miscellaneous information for an icon management software program and does not compensate for the deficiencies of XP or Gardner. Viellescaze is directed to animating a figure in three dimensions (see Viellescaze Abstract), and does not compensate for the deficiencies of XP, Gardner, or YZ. Therefore, dependent claim 17 is also allowable over the prior art of record, at least for the reasons discussed above with regard to amended independent claim 13.

G) Obviousness Rejection Based on Microsoft XP screen caps, XP.pdf operating system (hereinafter “XP”), Gardner et al U.S. Patent No. 7,003,734 (hereinafter “Gardner”), and Viellescaze et al. U.S. Publ. No. 2004/0179043 (hereinafter “Viellescaze”).

Claim 23 was rejected under 35 U.S.C. §103(a) as being unpatentable over XP and Gardner, and in view of Viellescaze. Applicants respectfully traverse and request withdrawal of said rejection for the following reasons.

Claim 23 depends from amended independent claim 19. As discussed above, amended independent claim 19 is now allowable over the prior art of XP and Gardner. Viellescaze is directed to animating a figure in three dimensions (see Viellescaze Abstract), and does not compensate for the deficiencies of XP or Gardner. Therefore, dependent claim 23 is also allowable over the prior art of record, at least for the reasons discussed above with regard to amended independent claim 19.

H) Obviousness Rejection Based on Microsoft XP screen caps, XP.pdf operating system (hereinafter “XP”) and U.S. Patent No. 5,452,414 (hereinafter “Rosendahl”).

Claims 30-31 were rejected under 35 U.S.C. §103(a) as being unpatentable over XP in view of Rosendahl. Applicants respectfully traverse and request withdrawal of said rejection for the following reasons.



Independent claim 30 has been amended to require, in part, “wherein the animated three-dimensional appearing icon provides an animated indication of a first action that will occur if a first menu item is selected, and further morphs into a second appearance when the pointer moves over a second menu item to provide an animated indication of a second action that will occur if the second menu item is selected.” Support for said amendment is described in Applicants’ specification at para. 45. The prior art of XP and Rosendahl are silent as to an animated icon morphing from one appearance to another appearance in response to a pointer moving from a first menu item to a second menu item. Therefore, amended independent claim 30 is now allowable over the prior art of record. Similarly, dependent claim 31 is also allowable over the prior art of record, at least for the reasons discussed above with regard to amended independent claim 30.

### **CONCLUSION**

For at least the reasons stated above, claims 1-24 and 30-31 are now in condition for allowance. Applicants respectfully request withdrawal of the pending rejections and allowance of the claims. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned – 202/783-8400 or [nberezny@shb.com](mailto:nberezny@shb.com) (such communication via email is herein expressly granted) – to resolve the same. It is believed that no fee is due, however, the Commissioner is hereby authorized to charge any amount required to Deposit Account No. 19-2112 with reference to Attorney Docket Number 306210.01/MFCP.139203.

Respectfully submitted,

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